

### **REMARKS**

Claims 21-32 are pending in this application after entry of this paper. Claims 21-32 are amended as discussed below. Reconsideration of the claims in light of the amendments, presented above, and the remarks presented below is respectfully requested.

With respect to all amendments and canceled claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

#### **Specification**

The disclosure was objected to because of informalities. The specification was amended as suggested by the Examiner. Accordingly, Applicants respectfully request withdrawal of this objection.

#### **Claim Objections**

Claims 22-26 and 28-32 were objected to because of informalities. The claims were amended as suggested by the Examiner. Accordingly, Applicants respectfully request withdrawal of this objection.

#### **Claim Rejections under 35 U.S.C. § 112, second paragraph**

Claim 27 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for insufficient antecedent basis. Claim 27 has been amended solely to provide technical clarity. By this amendment, Applicants are not surrendering any subject matter, nor limiting the scope of the claim. Accordingly, Applicants respectfully request withdrawal of this rejection.

**Claim Rejections under 35 U.S.C. § 101**

Claims 21-26 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner's basic position appears to be that the term "electron transfer moiety" is broad enough to cover any moiety. Applicants' respectfully disagree with this position, but in the interests of furthering the prosecution, have amended the claims to recite that the electron transfer moieties are transition metal complexes. Thus this rejection should be withdrawn.

**Claim Rejections under 35 U.S.C. § 112, first paragraph**

Claims 24-26 and 27-32 were rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Applicants respectfully disagree on the following two grounds.

First, claims 24-26 and 27-32 are not new matter. Adequate support for the claims is provided in the specification as filed to reasonably convey to one skilled in the relevant art that Applicants had possession of the claimed invention at the time the application was filed. For example, the paragraph starting on page 21, line 17 describes the addition of an electron transfer moiety to nucleosides. The paragraph starting on page 21, line 29 describes the making of a 2' or 3' modified nucleotide triphosphate. Furthermore, the paragraph starting on page 33, line 3 describes the use of ruthenium or iron (as well as other metals) as part of the transition metal complex. Accordingly, Applicants respectfully request withdrawal of this rejection.

Secondly, the same rejection was raised by Examiner S. Zitomer in an Office Action dated May 20, 2003. A timely response traversing the rejection was filed and overcame the

rejection. The Examiner is invited to review the filed comments therein. Accordingly,

Applicants respectfully request withdrawal of this rejection.

**Claim Rejections under 35 U.S.C. § 102(b)**

Claims 21-23 and 27-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by Inoue et al., U.S. Patent No. 4,965,350. In particular, the Examiner asserts that Inoue teaches a pyridopyrimidine nucleotide with a hydroxyl group on its 2' position, and asserts that this is a nucleotide triphosphate with an electron transfer moiety attached.

Claims 21-23 and 27-29 have been amended to include the presence of a transition metal complex. Such a structure is not disclosed in Inoue. Hence, the amended claims are patentably distinguishable over Inoue. Accordingly, Applicants respectfully request withdrawal of this rejection.

**Claim Rejections under 35 U.S.C. § 102(b)**

Claims 21-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lehninger (Biochemistry, second edition, published on October 1975). In particular, the Examiner asserts that NTP taught by Lehninger has three phosphates and a hydroxyl group on the 2' position of its ribose, and asserts that this is a nucleotide triphosphate with an electron transfer moiety attached. The arguments set forth above for the Inoue reference apply equally to Lehninger. Like Inoue, Lehninger does not disclose any transition metal complexes as claimed in amended claims 21-23. Hence, the amended claims are patentably distinguishable over Lehninger. Accordingly, Applicants respectfully request withdrawal of this rejection.

**CONCLUSION**

Applicants respectfully submit that the amended claims are in form for allowance and an early notification of such is requested. If the Examiner believes that any unresolved issues may be disposed of by telephone, he is respectfully requested to call the undersigned at (415) 781-1989. This paper is filed under 37 C.F.R. § 1.34(a).

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Respectfully submitted,

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Filed under 37 C.F.R. § 1.34(a)